REMARKS

I. General

Claims 1-39 are pending in the present application. Claims 1-2, 4, 6-12, 15, 18-25, 27-30, 33-34 and 36-39 are rejected under 35 U.S.C. § 102. Claims 3, 5, 13, 15-17, 26, 31, 32 and 35 are rejected under 35 U.S.C. § 103. Applicant respectfully traverses the rejections of record.

Claims 9 and 26 have been amended in the present amendment. Specifically, claim 9 has been amended to add clarifying language and thus make the relationship between the plurality of mail pieces and printed postage indicia more clear. It is believed that the amendments do not alter the scope of the claim, but rather more clearly and expressly set forth the originally submitted limitations. No new matter has been added.

Claim 26 has been amended to correct a typographical error and now includes the inadvertently omitted period at the end of the sentence. Therefore, this amendment is not intended to narrow the scope of claim 26 from the scope previously afforded to claim 26. No new matter has been added.

II. Rejections Under 35 U.S.C. § 102(b)

Claims 1-2, 4, 6-12, 15, 18-25, 27-30, 33-34 and 36-39 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Publication No. 2002/0073039 to Ogg et al. (hereinafter *Ogg*). It is well settled that to anticipate a claim, a reference must teach every element of the claim, see M.P.E.P. § 2131. In order for a reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Moreover, the Examiner has the burden of establishing a *prima facie* case of anticipation. *See In re Skinner*, 2 U.S.P.Q.2d 1788, 1788-89 (B.P.A.I. 1986) (stating, "[i]t is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office."). Applicant respectfully asserts that the rejections do not satisfy the foregoing requirements and that the Examiner has not established *prima facie* anticipation under 35 U.S.C. § 102 with respect to the claims.

A. The Independent Claims

Claim 1 recites "a controller for monitoring the mail pieces as they are processed by the system . . . ." The Office Action cites *Ogg* paragraph [0031] as teaching this limitation. Office Action page 2. However, the identified portion of *Ogg* fails to disclose a controller for monitoring the mail pieces as they are processed by the system. Instead, paragraph [0031] teaches a window 104 into which a user may enter postage rates in free form or use a postage calculator to calculate postage rates. *Ogg*, paragraph [0031]. Accordingly, the rejection of record fails to establish a *prima facie* case of anticipation under 35 U.S.C. § 102 with respect to "a controller for monitoring the mail pieces as they are processed by the system" recited in claim 1.

Moreover, claim 1 recites "each of the labels is associated with a particular mail piece" (emphasis added). The Office Action cites *Ogg* paragraph [0034] as teaching this limitation. Office Action page 2. However, the cited paragraph fails to teach each of the labels is associated with a particular mail piece. In paragraph [0034], *Ogg* teaches the system determines whether the print wizard was used to generate the print request. *Ogg*, paragraph [0034]. *Ogg* explains that when the wizard is not used, the rate class defaults to first class. *Ogg*, paragraph [0034]. Determining whether or not a print wizard was used, and defaulting to first class when the wizard is not used, does not teach each label is associated with a particular mail piece. Therefore, the rejection of record does not establish a *prima facie* case of anticipation under 35 U.S.C. § 102.

Claim 1 further recites "an applicator for applying the labels to mail pieces." The Office Action cites *Ogg* paragraph [0026] as teaching this limitation. Office Action page 2. However, the cited paragraph fails to teach an applicator for applying the labels to mail pieces. Figure 2 of *Ogg* shows no applicator for applying labels after the printing step, and paragraph [0026] of *Ogg* teaches once the postage is printed on a label, the user may place the postage on a mail piece. *Ogg*, paragraph [0026]. Accordingly, a *prima facie* case of anticipation under 35 U.S.C. § 102 has not been established with respect to claim 1.

Claim 9, as amended, recites "receiving information associated with a plurality of mail pieces [and] printing said plurality of postage indicia corresponding to the required postage amounts on blank labels to create postage stamps, wherein each of the postage

stamps is associated with a particular one of the plurality of mail pieces . . . ." *Ogg* does not teach receiving information associated with a plurality of mail pieces and printing a plurality of postage indicia on blank labels, wherein each of the postage stamps is associated with a particular one of the plurality of mail pieces. Accordingly, claim 9 is not anticipated under 35 U.S.C. § 102 by *Ogg*.

Claim 24 recites "printing postage indicia corresponding to the postage amount on blank labels . . . ." The Office Action cites *Ogg* paragraph [0036] as teaching this limitation. Office Action page 6. However, at the cited paragraph, *Ogg* teaches printing postage indicia upon "Postagio" labels having pre-printed security information thereon. See *Ogg*, Figure 6. Accordingly, a *prima facie* case of anticipation under 35 U.S.C. § 102 has not been established.

Claim 24 further recites that "each of the postage stamps is associated with a particular one of the mail pieces . . . ." The Office Action also cites paragraph [0036] of *Ogg* as teaching this limitation. Office Action page 6. However, the cited paragraph fails to teach each of the postage stamps is associated with a particular one of the mail pieces. The cited portion of *Ogg* does not appear to be relevant to the foregoing claim language, teaching the use of "Postagio" labels having pre-printed serial numbers thereon. A *prima facie* case of anticipation has therefore not been established with respect to claim 24.

B. The Dependent Claims

Claims 2, 4, 6-8, 10-12, 15, 18-23, 25, 27-30, 33-34 and 36-39 each depend directly or indirectly from a respective one of claims 1, 9, and 24, thereby inheriting each limitation of the respective base claim. Therefore, at least for the reasons advanced with regard to claims 1, 9, and 24, *Ogg* fails to anticipate the dependent claims. Moreover, the dependent claims introduce new limitations for which *prima facie* cases of anticipation have not been made of record.

III. Rejections Under 35 U.S.C. § 103(a)

Claims 3, 26 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ogg*. Claims 5, 13, 15-17, 31 and 32 are rejected under 35 U.S.C. § 103(a) as being

unpatentable over *Ogg* in view of U.S. Publication No. 2003/0140017 to Patton et al. (hereinafter *Patton*). Applicant traverses the rejections of record.

Applicant respectfully asserts that *Ogg* is not a valid prior art reference under 35 U.S.C. § 103. As amended by the American Inventor's Protection Act of 1999 (the Act), signed on November 29, 1999, section 103(c) now states:

> (c) Subject matter developed by another person, which qualifies as prior art only under one or more of sub-sections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Section 4807 of the Act further provides that this new provision applies to any application filed on or after the date of enactment, November 29, 1999. The present application was filed November 29, 2003. Thus, the filing date of this application is after the effective date of the new law. *See* 37 C.F.R. § 1.53(d)(2).

Ogg is, and was at the time the present invention was made, owned by the same entity or subject to an obligation of assignment to the same entity as the present application. The Examiner will note that *Ogg* and the present application are assigned to the same entity, Stamps.com. The disclosure of *Ogg* is available only as 35 U.S.C. § 102(e)-type art. Accordingly, 35 U.S.C. § 103(c) now provides that *Ogg* "shall not preclude patentability" of the claimed invention. Therefore, the 35 U.S.C. § 103 rejections of claims 3, 5, 13, 15-17, 26, 31, 32, and 35 should be withdrawn.

IV. **Summary**

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant therefore requests that the present claims be passed to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P022US/10303187 from which the undersigned is authorized to draw.

Dated: June 20, 2007

Respectfully submitted,

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: June 20, 2007

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(Lisa deCordova)

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